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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,527	12/20/2004	Hiroyuki Furuya	10407-118US(A3034MT-US1)	6795

570            7590            01/19/2007  
AKIN GUMP STRAUSS HAUER & FELD L.L.P.  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103

EXAMINER
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HUGHES, JAMES P

ART UNIT	PAPER NUMBER
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2883

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/518,527	FURUYA ET AL.
	Examiner	Art Unit
	James P. Hughes	2883

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 December 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 December 2004 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date <u>122004 81105 112906</u> .	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### *Claim Objections*

1. Claims 7 and 8 are objected to because claim 7 recited the limitation “the resonator” which does not have an antecedent basis. Clam 8 is objected to because it inherits the deficiencies of claim 7. Appropriate Action is required.
2. Claim 9 is objected to because it recites the limitation “the modulation frequency” which does not have an antecedent basis. Appropriate Action is required.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yi et al. (6,055,342). Yi teaches a non-linear optical electrical/optical converter (modulator) apparatus comprising; a waveguide (204) in a LiNbO<sub>3</sub> dielectric substrate (200) which is capable of receiving and propagating a modulated optical signal, a pair of electrodes (e.g. 208) disposed on a top surface of the substrate opposite each other sandwiching the waveguide and capable of applying an electric field in the waveguide by a nonlinear effect and experiencing a change in electric field in the waveguide. As light propagates through the waveguide (204) it will

inherently generate an electric field (i.e. TE) in said waveguide. (See Col. 3, ll. 60 – Col. 4, ll. 30 and Fig. 2)

Yi does not explicitly teach a resonator or resistor coupled to the electrodes (208) or a frequency range for which the device may operate.

Yoshinori teaches a radio wave generator where light (e.g. from 21,22) passes through a modulator (31) and interacts with a non-linear element (10)—thin film waveguide which intern creates an electric interaction which is broadcast as a radio wave of frequency equal to the light passing through the waveguide. (See Abstract and Figs. 1 and 4)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the invention Yoshinori into the invention of Yi to allow an efficient transfer of optical to electrical signals, at frequencies of higher than 10GHz . One would have been motivated to do so because Yoshinori teaches that the conversion of optical to electrical information is advantageous and Yi teaches an efficient modulation source, thus the intention of Yi would allow for more efficient radio signal production from the frequencies of lightwaves employed in communications systems.

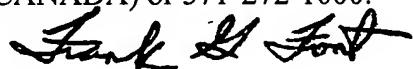
### *Conclusion*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references listed on the attached PTO 892 teach related art to this invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James P. Hughes whose telephone number is 571-272-2474. The examiner can normally be reached on Monday - Friday 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font can be reached on 571-272-2415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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